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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/918,944 08/25/97 SAWYER

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EXAMINER

QM12/0208

WILBURN L. CHESSER, ESQ.
JONES JAIN, LLP
1110 VERMONT AVENUE, NW SUITE 1150
WASHINGTON DC 20005

SAGER, M	
ART UNIT	PAPER NUMBER

3713
DATE MAILED:

02/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08918944

Applicant(s)

Sawyer et al

Examiner

Sager

Group Art Unit

3713

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three(3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 20 Nov 2000
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 48-94 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 48-94 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

MARK SAGER
PRIMARY EXAMINER

Part of Paper No. _____

Prior Public Use or Sale

1. An issue of public use or on sale activity has been raised in this application due to First Use in Commerce of Ten Stix 21 trademarked game is recorded within the U.S. Trademark Office as being June 1, 1996 and due to marketing pamphlet distributed at World Gaming Congress and Expo in October 1997 detailing an electronic display version of Ten Stix 21 trademarked game. First Use in Commerce has legal definition applicable to prior public use or sale issue. In order for the examiner to properly consider patentability of the *claimed invention* under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: data supporting first commercial use and data supporting public testing or public showing including for gaming commission compliance requirements. *Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.*

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is *required*: if the language 'successive tiers of bonus levels' (clm 52, lines 4-8, 30-33) refers to bonus point levels as in successive bonus points accumulated up to a singular prize level, the language does not have proper antecedent with respect to originally filed specification. Essentially, the claim language 'bonus level' is used in the art to mean prize level; however, the language has been interpreted herein to be successive bonus [point] levels which are not successive prize levels but rather successive points to reach the only prize level commensurate with that found in claim 54, lines 10-17.

3. The amendment filed Nov. 20, 2000 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: 'player participation indicator' (clms 72-73) is not disclosed, suggested or taught in originally filed specification. Additionally, alternatively, if the language 'successive tiers of bonus levels' (clm 52, lines 4-8, 30-33) refers to successive prize levels, the originally filed specification fails to enable a plurality of successive prize levels such that there is a tiering of prize levels. The specification enables a singular prize level and not successive tiers of prize levels. Thus, successive tiers of bonus levels being a plurality of successive prize levels is not enabled.

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 52-53 and 72-73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification fails to enable a 'player participation indicator', and fails to enable 'successive tiers of bonus levels' if that language refers to successive prize levels (supra).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 56-58 and 94 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 56-58 are indefinite since the device is inept in that the steps are manual playing steps performed by humans rather than the structure of the device.

The phrase 'rules of play' (clm 94) is indefinite for attempting to claims steps of an auxiliary game within an apparatus claim where the steps are undefined therein due to failure to definitively claim the particular steps to play the auxiliary game and therefore scope of this language is uncertain and protection sought by this phrase is not defined.

Claim Rejections - 35 USC § 103

8. Claims 68-71, 74-78 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al (5586766) in view of Ten Stix 21 Game in Applicant's background disclosure. It is noted for Applicant's consideration that there is no means or structure disclosed or taught for distinguishing whom is activating the various units and displays such that the claimed apparatus is unable or inept to discern whether a 'player' or 'dealer' or 'other' is activating; however, the designations are treated herein as the house or casino discerns whom is operating.

Where at least one light emitting element associated with each indication is a prize display having one prize indicated, Forte discloses a blackjack game system and method (1:11-13; 2:33-43; 3:41-14:51, figs. 1-21) as an apparatus for controlling and displaying each player's progress in

an auxiliary incentive game played simultaneously with a principal or primary casino table game directed by a dealer or croupier and played on a gaming table, the auxiliary game involving each player receiving bonus points during the course of playing the primary game and each player being eligible to receive a prize only after accumulating a predetermined number of bonus points (abstract, 3:42-7:65) comprising a bonus point display including a display element having an array of 'n' luminous indicators being mounted adjacent to the player (refs. 210-217, 441-446, 451-456) or being a common display mounted at the gaming table (refs. 20, 22, 42, 44, figs. 1-20), a controller (40) connected to the point display (figs. 1-20, esp. 5), having a first input device receiving an input indicating a bonus point award for each of said players (26, 28) to cause the display to display an incremented number of bonus points received by each player (5:40-6:52, figs. 1-20, esp. 1-10), a second device causing the display to reset and to display a starting number of bonus points as a means for resetting the bonus point display (7:12-24; 8:16-29), a prize display including an indication of at least one prize available to the player with at least one light emitting element associated with the at least one prize and a third means for controlling the light emitting elements to indicate the prize received by each player (4:53-5:15; 6:53-7:11; 7:35-65; 8:32-39; 11:40-65; 14:29-51, figs. 1-20), a dealer interface unit including dealer control elements (5:40-6:27; 7:13-8:40; 11:5-23 and 40-65; 13:7-14:51, figs. 1-20, refs. 20, 22, 26, 28) and a prize display including an indication of one prize (4:53-5:20; 6:53-7:11, 7:36-64; 8:30-40; 11:50-65; 14:29-50). Forte's auxiliary game includes monitoring the primary game and counting tally events (3:41-4:52) and awarding a bonus or prize to each player who reaches a predetermined threshold (4:53-5:15) and contemplates other events (10:28-29; 13:17-39; 15:28-49) where the auxiliary

game is offered in *order to better hold the player's desire to continue playing the game* (2:32-42) and to make the game *more exciting to play than conventional blackjack* due to providing a variety of jackpots or different jackpot possibilities the players hope to win (10:15-30). Further, Forte includes displaying information to dealer and players (8:5-8 and 30-40; 11:53-65), but does not appear to include 'prompting the dealer to manipulate the dealer control elements in accordance with rules of play of the auxiliary game'. It is well known that casino and gaming environments are typically loud and can be distractive even to an employee such as a dealer which therefore may cause employees to error or make mistakes. Further, it is known in gaming and computing to provide help or instruction information based upon context or game/application state to aid a user in using the game/application. Prompting is a method of providing instructional information based upon game/application state so as to request or prompt appropriate input. Therefore, it would have been obvious to an artisan of gaming, programming and help systems at the time the invention was made to add 'prompting the dealer to manipulate the dealer control elements in accordance with the rules of play of the auxiliary game' as known to Forte's game and method to aid the dealer provide appropriate input in the loud and occasionally distractive casino environment to reduce dealer error.

Forte does not disclose using the controller to 'maintain a number of bonus points received by each player when there is no new bonus points to be awarded' (clm 68, lines 12-13), resetting the bonus point display in response to 'the number of bonus points received by the associated player reaching a predetermined number of points' (clm 68, lines 14-15) since Forte's auxiliary game involves successive bonus or tallying events which zero's out the accumulated

bonus events when no new bonus points is to be awarded and does not necessarily zero out the bonus points when a player claims a bonus since Forte's auxiliary game contemplates higher award for subsequent successive accumulated bonus/tally events (4:66-67). However, Ten Stix 21 Game is a well known auxiliary game disclosed by Applicant's background (3:3-6:18) played with blackjack or other table games that counts bonus events during each player's playing of the primary game and participation in the auxiliary game where the auxiliary game includes maintaining a 'number of bonus points received by each player when there is no new bonus points' being displayed by displaying the counters or lammers on the table in front of each respective player (3:7-12, 18-28; 4:15-22; 5:10-18) and resetting the displaying of counters to a starting number of bonus points being zero in response to the 'number of bonus points received by the associated player reaching a predetermined number of bonus points' (3:12-17; 4:15-22; 5:10-18) for the player to exchange the bonus points for the offered prize (5:10-18) in order to provide incentive for players to stay at the table playing regardless of whether they are winning or losing the primary game but have a stake in the auxiliary game and become determined to win the bonus prize as they accumulate more bonus points (3:12-17; 5:1-9). It is so very well known in gaming to provide a plurality of games for players in order to better attract players since having a larger selection of games increases the opportunity that a player will find a game to their liking and stay to play. Thus, it would have been obvious to an artisan of games at the time the invention was made to add Ten Stix 21 Game including 'to maintain a number of bonus points received by each player when there is no new bonus points to be awarded' and to reset the bonus point display in response to 'the number of bonus points received by the associated player reaching a

well known

predetermined number of points' as well known and disclosed in Applicant's background disclosure to Forte's game and method to better attract players by providing an alternative auxiliary game by providing a variety of auxiliary games to increase the likelihood that a player will find a game to their liking, to provide incentive for players to stay at the table playing regardless of whether they are winning or losing the primary game (disclosure, 3:12-17; 5:1-9), *to better hold the player's desire to continue playing the game* (Forte, 2:32-42) and to make the game *more exciting to play than conventional blackjack* due to providing a variety of jackpots or different jackpot possibilities the players hope to win (Forte, 10:15-30).

Alternatively, Applicant's background disclosure states that the Ten Stix 21 Game (3:3-6:18) includes an auxiliary incentive game played simultaneously with a principal or primary casino table game directed by a dealer or croupier and played on a gaming table, the auxiliary game involving each player receiving bonus points during the course of playing the primary game and each player being eligible to receive a prize only after accumulating a predetermined number of bonus points which includes displaying the number of bonus points received by each plurality of players at the gaming table (3:7-12, 18-28; 4:15-22; 5:10-17), indicating a bonus point (3:3-28, 4:15-22; 5:10-17), displaying an incremented number of bonus points received by each player (3:3-28; 4:15-22, 5:10-17), maintaining display of a number of bonus points received by each player when no new bonus points is to be awarded, reset the display to display a starting number of bonus points in response to the number of bonus points received by the associated player reaching a predetermined number of bonus points (3:3-28, 4:15-22; 5:10-17), resetting the display when the associated player leaves the gaming table (5:18-6:3) where the auxiliary bonus game is

offered to provide incentive for players to stay at the table playing regardless of whether they are winning or losing the primary game but have a stake in the auxiliary game and become determined to win the bonus prize as they accumulate more bonus points (3:12-17; 4:30-5:9). However, the Ten Stix 21 game is disclosed as tracking and displaying the bonus points in a manual manner with counters called lammers and therefore, does not disclose an 'apparatus for controlling and displaying on a bonus point display' being a display with a 'controller connected to the bonus point display' with the controller having a 'first device to receive an input indicating a bonus point award for each player' and 'causing the [bonus point] display to display an incremented number of bonus points received by each player' and a 'second device to reset the display' with a 'means of resetting', a 'dealer interface unit' and a 'prize display including an indication of one prize'. The recording responsibilities of manually counting, displaying and keeping track of each players points is burdensome upon the dealer and essentially requires the dealer to be mindful of two sets of rules and operations for the primary game and the auxiliary or secondary game. It is well known in the displays or exhibitors, counters or gaming arts to use electronic counters and display devices for tracking and displaying counts electronically in an automated or semi-automated manner to ease record keeping duties of a user so as to reduce user counting error. Forte discloses a game and method that electronically aids a dealer count, record, display and keep track of bonus points to award players jackpot or prize opportunities upon reaching a predetermined value by using electronic displays and counters thereby teaching an 'apparatus for controlling and displaying on a bonus point display' being a display with a 'controller connected to the bonus point display' with the controller having a 'first device to receive an input indicating a bonus point

well known

award for each player' and 'causing the [bonus point] display to display an incremented number of bonus points received by each player' and a 'second device to reset the display' with a 'means of resetting', a 'dealer interface unit' so as to electronically record game progression and to ease record keeping requirements of the game for the dealer so as to reduce counting and tracking error and a 'prize display including an indication of one prize' for added visual impact to serve as an attraction to draw players to the game system (4:53-5:20; 6:53-7:11, 7:36-64; 8:30-40; 10:15-30; 11:50-65; 14:29-50) where the auxiliary game is offered in *order to better hold the player's desire to continue playing the game* (2:32-42) and is *more exciting to play than conventional blackjack* since it provides a variety of jackpot features of different jackpot possibilities that the players hope to win (10:15-30). Further, it has been deemed obvious to add 'prompting the dealer to manipulate the dealer control elements... game' to Forte's game and method to aid the dealer in game progress in the loud and occasionally distractive casino environment to reduce dealer error. Finally, it would be have been obvious to an artisan of gaming, counting, displaying and programming at the time the invention was made to add an 'apparatus for controlling and displaying on a bonus point display' being a display with a 'controller connected to the bonus point display' with the controller having a 'first device to receive an input indicating a bonus point award for each player' and 'causing the [bonus point] display to display an incremented number of bonus points received by each player' and a 'second device to reset the display' with a 'means of resetting', a 'dealer interface unit' including 'prompting' and a 'prize display including an indication of at least one prize' as disclosed by Forte to Ten Stix 21 game as disclosed by Applicant's background disclosure so as to automate the Ten Stix 21 game for easing record

keeping requirements of the game for the dealer and to reduce errors in counting and tracking where the auxiliary game is offered in *order to better hold the player's desire to continue playing the game* by making the conventional blackjack game more exciting (Forte, 2:32-42; 10:15-29) or to provide incentive for players to stay at the table playing regardless of whether they are winning or losing the primary game since the player's have a stake in the auxiliary game and become determined to win the bonus prize as the players accumulate more bonus points (Applicant's disclosure, 3:12-17; 4:30-5:9). It is noted that each auxiliary game (Ten Stix 21 and Forte) is an incentive game played in conjunction with a table game with bonus or tally points accumulated while playing a primary game of blackjack or other table game so as to increase casino revenue by including an incentive for the player to continue playing in the form of a bonus prize for each player reaching a predetermined number of bonus or tally points (*supra*) and that Forte teaches an apparatus which electronically tracks, displays and resets according to the rules of the auxiliary game to ease recording duties of the dealer so as to reduce dealer error. Thus, the combination of Ten Stix 21 game and Forte's game and method taken as a whole suggests to an artisan of gaming an apparatus for controlling and displaying each player's progress in Ten Stix 21 or other bonus/tally event auxiliary game played simultaneously with blackjack or other primary casino table game directed by a dealer played on a gaming table with the auxiliary game involving each player receiving bonus points during the course of playing the primary game and each player being eligible to receive a prize only after accumulating a predetermined number of bonus points in order to increase revenues for the casino by making game more exciting than conventional

blackjack due to providing an incentive for the players to keep playing while easing the record keeping duties of the auxiliary game for the dealer (supra).

9. Claims 72-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte (5586766) in view of Ten Stix 21 Game as disclosed in Applicant's background as applied to claims above, and further in view of either Paulsen (5393067) or Huard (5743800) or Jones (5544893). Forte in combination with Ten Stix 21 discloses an apparatus for controlling and displaying each player's progress in an auxiliary incentive game (supra) including an ante as a player participation indicator for providing an indication of whether each player has paid an additional wager to participate in the auxiliary game (5:20-30; 10:15-30) but does not provide an indicator which is a display such as an light emitting diode or other display. Huard, Jones and Paulsen each disclose table devices comprising a player participation indicator for providing an indication of whether each player of the primary game has paid an additional wager to participate in the auxiliary game'. It is well known to use wager acceptance devices which include a player participation indicator so as to clearly indicate each players' participation status. Indicating player participation by placing wagers at designated areas on the game table invites situations which disrupt flow of play and thereby decrease playing time which subsequently reduces casino revenue. Some situations which may disrupt game play include misplaced wagers either due to a player not actually placing the wager or due to the wager being 'moved' by a person (e.g. dealer, player or observer) either advertently or inadvertently which causes confusion as to what was the intent of the wager or funds/chips on the table. These situations cause disruptions due to players and dealers needing to 're-establish' what was the intent of funds on the table. Using game tables

as taught by either Huard or Jones or Paulsen reduce or eliminate these situations since the game table includes a player participation indicator which clearly indicates each players' participation status. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a 'player participation indicator' as taught by either Huard, Jones or Paulsen to Forte's game and method in combination with Ten Stix 21 auxiliary game to clearly indicate each player's participation status in the game so as to avoid situations which may reduce casino revenue due to disrupting game play.

10. Claims 54-65 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al (5586766) in view of Ten Stix 21 Game disclosed in Applicant's background disclosure as applied to claims 68-71, 74-78 and 94 above, and further in view of Adams (5848932). Forte in combination with Ten Stix 21 Game discloses a game and method for tracking an auxiliary game from a device for controlling progress of an incentive game (supra) which offers prizes so as to better hold the players desire to continue playing the game (supra) comprising 'prevents unauthorized transfer of the accumulated bonus points to and from each player' (Applicant's background disclosure, 4:23-5:1 and 18-22), 'providing an option to select to advance at least one tier a player bonus level from a player (disclosure, 3:24-28, as game step, or; Forte, 5:21-30, 10:25-28 as a wager), 'selecting to receive a bonus point in an auxiliary game upon occurrence of at least one bonus card event' and 'selecting to use a preselected card in an auxiliary game' (disclosure, 3:24-28), a 'preventive event where the event preventing one of the players to use the preselected card' (disclosure, 4:3-14), wherein the 'preventive event includes the preselected card triggering a bust event' (disclosure, 3:2-7:12) a 'speaker, wherein the speaker generates a

noise upon the prize being awarded' to attract patrons to the game (Forte, 14:29-36), 'flashing lights, the flashing lights flashing upon the prize being awarded' for added visual impact and to serve as an attraction to draw players to the game system by presenting a moving message scrolling or flashing display sign which presents an attracting message to bring players to the table (Forte, 6:53-7:11 and 34-65; 8:16-39; 11:18-65) and a 'display for displaying data regarding the auxiliary game' to present selected messages (Forte, 6:53-7:11 and 34-65; 8:5-8 and 16-39; 11:18-65, ref. 36).

Thus, Forte in combination with Ten Stix 21 Game discloses the claimed features/steps including preventing unauthorized transfer of bonus points between players (supra) but fails to disclose 'player interface unit is manipulated ... prize' (clm 54, lines 20-21), 'dealer interface unit... from the dealer interface unit' (clm 55, lines 2-7), 'player control element... players' (clm 59, lines 2-4), 'selected from a plurality of prizes... prizes' (clm 60, lines 1-3), 'randomizer... prizes' (clm 61, lines 1-3) and 'associated probability of selection' (clm 62, line 2), 'associated value... selection' (clm 63, lines 2-4). Essentially, Forte in combination with Ten Stix 21 Game includes the accumulating and displaying of bonus points, and the determining, indicating and announcing (visual or audible) of awards and points, but fails to disclose or suggest the player actuating a device for selecting a prize from a plurality of prizes, randomizing the prize selection with differing odds and prize values, the prize display providing a sequencing pattern and providing sound during the prize selection (in summary).

Adams discloses a method of playing game and games including a bonus indicator with randomizing payout of a plurality of different prizes having different values and different odds or

probabilities of selecting each of the prizes in an auxiliary game with selection or actuation being by player after the house enables the player award switch (2:2-7 and 31-36; 3:52-4:16 and 26-64; 6:9-23; 8:26-31, figs. 1-3) so as to heighten the level of anticipation and excitement (4:26-33) for added player excitement while the casino controls game progression (8:22-39) thereby teaching 'player interface unit is manipulated by the associated player to select the prize' (2:1-9; 28-36; 8:5-39), 'dealer interface unit operatively coupled to the controller for signaling the controller wherein the dealer control element of the dealer interface unit signals the controller to activate the player interface unit associated with the player who has' achieved a bonus condition (2:1-9, 28-36; 3:52-55; 4:9-64; 5:21-50; 6:25-7:5; 8:5-39), 'wherein the player interface unit is activated by the controller in response to a signal from the dealer interface unit' (2:1-9 and 28-46; 8:22-31), 'player control element including a selector, such that a selection of prize is receivable from the associated one from the plurality of players' (2:1-9 and 28-46; 8:22-31), 'selected from a plurality of prizes... plurality of predetermined prizes' (6:53-7:5), 'randomizer operatively coupled to the controller, the randomizer randomly selecting the prizes from the plurality of predetermined prizes' (5:39-50) and 'each of the plurality of prizes has an associated probability of selection' (5:39-50) so as to heighten the level of anticipation and excitement as they observe a display approaching a winning position (4:26-33) and for added or increased player excitement while the casino or house retains/controls game progression (2:31-36; 4:26-33 and 50-58; 6:9-44; 8:5-39).

However, Adams does not clearly disclose 'varying inversely with the associated probability of selection' (clm 63). Adams discloses randomizing the prize selection with each of the plurality of predetermined prizes having an associated value and an associated probability of

selection (5:39-41; 6:62-7:11). Further, it is so very well known in gaming and prize distribution to provide payout or prizes with values inversely proportional to their random selection so the value of the prize 'varying inversely with the associated value... probability of selection' in order to relate the value of the prize to their probability of selection which permits larger value prizes to be won which increases player interest and participation in the [auxiliary] game. Increased player participation in a house game correspondingly increases house revenue. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add 'varying inversely with the associated probability of selection' as so very well known in gaming and prize distribution to Adams' method of playing and payout indicator for an alternative process of prize selection that increases prize value for added or increased player excitement and participation in the game. Finally, it would have been obvious to an artisan of gaming at the time the invention was made to add 'player interface unit is manipulated ... prize', 'dealer interface unit... from the dealer interface unit', 'player control element... players', 'selected from a plurality of prizes... prizes', 'randomizer... prizes' and 'associated probability of selection' 'associated value... selection' as taught by Adams or as known to Forte's table game and method in combination with Ten Stix 21 Game so as to heighten the level of anticipation and excitement as they observe a display approaching a winning position (4:26-33) and for added or increased player excitement while the casino or house controls game progression (2:31-36; 4:26-33, 50-58; 6:9-44; 8:5-39).

11. Claims 48-53, 66 and 75-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al (5586766) in view of Ten Stix 21 Game disclosed in Applicant's background disclosure as applied to claims 68-71, 74 and 94 above, and further in view of Adams (5848932)

as applied to claims 54-65 and 67 above, and further in view of Pickardt (GB 2201821A). Where at least one light emitting element associated with each indication is a plurality of prize lighted indications, Forte in combination with Ten Stix 21 Game, and further in view of Adams discloses a game and method for tracking an auxiliary game from a device for controlling progress of an incentive game including a visual and audible announcers to attract or draw attention to the auxiliary game or provide game information, a prize display with indications of a plurality of predetermined prizes each having a differing value and differing odds or probability of selection, the controller being connected to the prize display, a player interface unit being manipulated by an associated player to randomly select a prize from a plurality of predetermined prizes and dealer interface unit signals the controller to activate the player interface unit associated with the player who has accumulated the predetermined number of bonus points so as to heighten the level of anticipation and excitement as the players observe a display approaching a winning position and for added or increased player excitement while the house controls game progression (supra).

Forte in combination with Ten Stix 21 Game, and further in view of Adams discloses the claimed features/steps including player manipulating a selector or control element on a player interface unit to randomly select a prize from a plurality of prizes with a separate indication for each of the different prizes and the indications of each prize being positioned on the prize display in a predetermined pattern as a rotational figure to indicate the prize received by each player (supra), but fails to disclose 'at least one emitting element associated with each indication' (clms 48, 50, 52, 75, 77), 'controlling the light emitting elements associated with the indications on the prize display' (clms 48, 50, 52, 75, 77), 'plurality of lights, at least one from the plurality of lights

corresponding to each of the predetermined prizes' (clm 66), 'indexes... generator' (clm 84, lines 2-4), 'controller signals the prize display... interface unit' (clm 87, lines 3-5), 'in a predetermined sequence' (clm 88, line 3), 'exhibiting a sequence... prize display' (clm 89, lines 3-5) and 'rotational sequence around the rotational figure pattern of indications' (clm 90, lines 3-4).

Essentially, Forte in combination with Ten Stix 21 Game, and further in view of Adams discloses the accumulating and displaying of bonus points, determining, indicating and announcing of awards either visually on a prize display or audibly through a speaker to draw attention to the game, and random selection of plurality of prizes but fails to disclose or suggest the particular prize display including a plurality of light emitting elements each associated with the indication on the prize display to indicate a prize with the prize display and controlling the light emitting elements to indicate the prize providing the particular sequencing pattern (in summary).

Regarding prevention of transfer feature (claim 48), Ten Stix 21 Game includes game rule for preventing transfer of bonus points between players (4:23-5:1 and 18-22), but does not include a 'device' performing the prevention capability of the casino. Forte's game and method discloses a device that counts, displays and resets bonus points electronically (supra) and provides no physical or tangible counter associated to the respective bonus points displayed electronically on the displays to a player (figs. 1-20). Further, the registering of bonus points is controlled by a dealers input without any player input (3:41-52; 6:7-13, figs. 1-20). Therefore, Forte in combination with Ten Stix 21 Game includes the 'device prevents unauthorized transfer of the accumulated bonus points to and from each player' due to the dealer controlling the registering of bonus points of the game without physical or tangible counters and without any player input

thereby reducing the record keeping duties of the dealer and thereby avoiding counting error (supra).

Pickardt discloses a gaming machine with a prize display (6:35-7:25, figs. 1-4) that randomizes awarding prizes for a prize condition for randomizing the prize selection comprising a prize display in the form of a circular wheel of lights teaching 'at least one light emitting element associated with each indication' (figs. 1-4 esp. 1), the controller being connected to the prize display with the controller comprising means for 'controlling the light emitting elements associated with the indications on the prize display to indicate the prize' (figs. 1-4, esp. 1 and 4) and .. prizes', 'plurality of lights, at least one for the plurality of lights corresponding to each of the predetermined prizes' (figs. 1 and 4), 'indexes through each of the different prizes on a random basis... time instant... generator' (6:35-7:25, esp. 7:21-25, figs. 1 and 4), 'controller signals the prize display to light the light emitting elements of each indication of each prize immediately prior to the selection of the prize resulting from the associated player manipulating the player control element of the player interface unit' (6:35-7:25, figs. 1 and 4), 'in a predetermined sequence' (7:13-25), 'exhibiting a sequence... lighting the light emitting elements is correlated to the predetermined pattern of indications on the prize display' (7:13-25, figs. 1 and 4), 'rotational sequence around the rotational figure pattern of indications' (7:13-25, figs. 1 and 4) to simulate an indicator rotating around a display of prizes in a stepwise fashion (7:13-18) whereby the player is given the opportunity of actually influencing game events thereby giving the player the impression he can influence the events of the game (1:28-2:8) to heighten the level of anticipation and excitement as the players observe one or more moving objects approaching a

winning position (Adams, 4:26-30) so the prize selection is clearly visible and audible (Adams, 4:30-32) with actuation of the bonus indicator being with great fanfare (Adams, 4:50-58) for added excitement while the house controls of game progression (Adams, 2:1-9, 31-36; 8:26-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add 'at least one emitting element associated with each indication', 'controlling the light emitting elements associated with the indications on the prize display', 'plurality of lights, at least one from the plurality of lights corresponding to each of the predetermined prizes', 'indexes... generator', 'controller signals the prize display... interface unit', 'in a predetermined sequence', 'exhibiting a sequence... prize display' and 'rotational sequence around the rotational figure pattern of indications' as taught by Pickardt to Forte's game and method in combination with the Ten Stix 21 Game, and further in view of either Adams to simulate an indicator rotating around a display of prizes in a stepwise fashion (Pickardt, 7:13-18) whereby the player is given the opportunity of actually influencing game events thereby giving the player the impression he can influence the events of the game (1:28-2:8) to heighten the level of anticipation and excitement as the players observe one or more moving objects approaching a winning position (Adams, 4:26-30) so the prize selection is clearly visible and audible (Adams, 4:30-32) with actuation of the bonus indicator being with great fanfare (Adams, 4:50-58) for added excitement while the house controls of game progression (Adams, 2:1-9, 31-36; 8:26-30).

Response to Arguments

12. Applicant's arguments with respect to claims 48-94 have been considered but are moot in view of the new ground(s) of rejection. However, to the extent that the Applicant's remarks

remain pertinent to the holdings for the claimed invention being unpatentable over the art, the following response is provided. Regarding the assertion that none of the prior art discloses or suggests a 'controller for causing the player interface unit to reset the display element to display the starting number of bonus points in response to the number of bonus points received by the associated player reaching a predetermined number of bonus points', the Applicants' background disclosure (*supra*) states that the Ten Stix 21 game is offered to provide incentive for players to stay at the table playing regardless of whether they are winning or losing the primary game since the player's have a stake in the auxiliary game and become determined to win the bonus prize as the players accumulate more bonus points (Applicant's disclosure, 3:12-17; 4:30-5:9) where the Ten Stix 21 teaches the manual counting and displaying of the number of bonus points being reset to zero upon the player reaching ten points (3:12-14, 18-28; 4:15-22; 5:10-18) due to the player exchanging the ten counters for the prize offered by the casino. Further, Forte discloses a table game and method with an auxiliary game (*supra*) offered in *order to better hold the player's desire to continue playing the game* by making the conventional blackjack game more exciting (Forte, 2:32-42; 10:15-29) where the table controller counts bonus events electronically coupled to displays to electronically count and display the games progression so as to ease the record keeping duties of the dealer and to reduce counting error. It is so very well known in gaming to provide a plurality of games for players in order to better attract players since having a larger selection of games increases the opportunity that a player will find a game to their liking and stay to play. Additionally, it is well known in the displays or exhibitors, counters or gaming arts to use electronic counters and display devices for tracking and displaying counts electronically in an

automated or semi-automated manner to ease record keeping duties of a user so as to reduce user counting error. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a 'controller causing the player interface unit to reset the display element to display the starting number of bonus points in response to the number of bonus points received by the associated player reaching a predetermined number of bonus points' as known and disclosed by Forte to Ten Stix 21 game so as to automate the Ten Stix 21 game for easing record keeping duties of the game for the dealer and to reduce errors in counting and tracking, where the auxiliary game is offered in *order to better hold the player's desire to continue playing the game* by making the conventional blackjack game more exciting (Forte, 2:32-42; 10:15-29) or to provide incentive for players to stay at the table playing regardless of whether they are winning or losing the primary game since the player's have a stake in the auxiliary game and become determined to win the bonus prize as the players accumulate more bonus points (Applicant's disclosure, 3:12-17; 4:30-5:9). Alternatively, it would have been obvious to an artisan at the time the invention was made to add to add the Ten Stix 21 game including 'causing the player interface unit to reset the display element to display the starting number of bonus points in response to the number of bonus points received by the associated player reaching a predetermined number of bonus points' as disclosed by Applicant's disclosure to Forte's game and method in order to better attract players by providing an alternative auxiliary game thereby providing a variety of auxiliary games to increase the likelihood that a player will find a game to their liking, to provide incentive for players to stay at the table playing regardless of whether they are winning or losing the primary game (disclosure, 3:12-17; 5:1-9), *to better hold the player's desire to continue*

playing the game (Forte, 2:32-42), to make the game *more exciting to play than conventional blackjack* due to providing a variety of jackpots or different jackpot possibilities the players hope to win (Forte, 10:15-30) and to electronically count, display and reset game progression for easing dealer record keeping duties and to reduce dealer error.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., providing an incentive to play) are not recited in any of the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, Forte teaches providing an auxiliary game more exciting to play than conventional blackjack due to providing a variety of jackpots the players hope to win (Forte, 10:15-30) where the auxiliary game is offered to better hold the player's desire to continue playing the game (Forte, 2:32-42). Further, the Applicants' background disclosure states Ten Stix 21 game is offered to provide incentive for players to stay at the table playing regardless of whether they are winning or losing the primary game since the player's have a stake in the auxiliary game and become determined to win the bonus prize as the players accumulate more bonus points (Applicant's disclosure, 3:12-17; 4:30-5:9)

Regarding Applicant's statement that the art does not disclose or suggest a controller to control display of bonus points, Forte teaches a controller to control display of bonus points in an auxiliary game offered to better hold the player's desire to continue playing the game (2:32-42) and Applicant's background discloses the Ten Stix 21 game displaying bonus points. The

combination suggests to an artisan at the time the invention was made a game device with a controller controlling the counting and displaying of bonus points in an auxiliary game to better hold the player's desire to continue playing the game while easing the record keeping duties of the dealer and thereby reduce counting errors (*supra*).

Regarding Applicant's argument (for claims 48-49 only) that the none of the art disclose or suggest a protective feature of preventing unauthorized transfer of bonus points among players, the examiner disagrees. The Applicant's background states the Ten Stix 21 Game includes game rule for preventing transfer of bonus points between players (4:23-5:1 and 18-22), but does not include a 'device' performing the prevention capability of the casino. Forte's game and method discloses a device that counts bonus points electronically (*supra*) and provides no physical or tangible counter associated to the respective bonus points displayed electronically on the displays to a player (figs. 1-20). Further, the registering of bonus points is controlled by a dealers input without any player input (3:41-52; 6:7-13, figs. 1-20). Therefore, Forte in combination with Ten Stix 21 Game suggests to an artisan of gaming, counters and displays a 'device prevents unauthorized transfer of the accumulated bonus points to and from each player' due to the dealer controlling the registering of bonus points of the game without physical or tangible counters and without any player input thereby reducing the record keeping duties of the dealer and thereby avoiding counting error (*supra*) and to provide an alternative auxiliary game so as to increase the likelihood a player will be attracted to play (*supra*).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in

a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicants appear to have misconstrued use of hindsight in this case. Hindsight reconstruction is proper only so long as it takes into account only knowledge within the level of ordinary skill in the art at the time the claimed invention was made and does not glean knowledge from applicant's disclosure. In this instance, Applicant's disclosed an auxiliary game that counts, displays and resets bonus points in a progression to an award (3:3-6:18) which also prevents transfer of points (4:23-5:1 and 18-22) where the auxiliary game is offered to provide incentive for players to stay at the table playing regardless of whether they are winning or losing the primary game since the player's have a stake in the auxiliary game and become determined to win the bonus prize as the players accumulate more bonus points (Applicant's disclosure, 3:12-17; 4:30-5:9). Forte discloses electronically counting, displaying and resetting bonus points obtained by each player during an auxiliary game to ease record keeping duties of the dealer and to reduce counting error and discloses providing a variety of jackpots the players hope to win so the game is more exciting to players than conventional blackjack (Forte, 10:15-30) where the auxiliary game is offered to better hold the player's desire to continue playing the game (Forte, 2:32-42). Further, it was so well known in gaming before the time of the claimed invention to provide a plurality of games in order to better attract players to play since a plurality of games increases the likelihood a player will game to their liking and, it was so well known in gaming,

counting and displaying to electronically count, track and display counting events for users in order to ease record keeping duties while reducing counting errors. Thus, the combination of Forte and the disclosed Ten Stix 21 game suggests to an artisan at the time the invention was made an auxiliary game with bonus points electronically counted, displayed, reset and prevented from transfer to reduce counting errors, ease record keeping duties for the dealer and to increase likelihood a player will stay to play due to both a plurality of games being offered which increases chance a player will find a game to their liking and added incentive for a player obtaining a prize from bonus events.

The combination of Forte and Ten Stix 21 (and other art in holdings herein) render claimed invention unpatentable.

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

14. This action is not made final so that Applicants may respond to new issues herein.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The World Gaming Congress Special Edition marketing brochure describes Ten Stix 21 game with electronic counters, displays, resetting and random prize award.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Valencia Martin Wallace, can be reached on

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(703) 308-4119. The fax phone number for this Group is (703) 305-3580. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



M. Sager
Primary Examiner
Jan 30, 2001